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ATTORNEY'S DOCKET NO.: 2001180-0075 (HU 1917-01 CIP)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

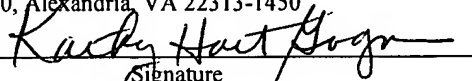
Applicant: Schreiber, *et al.*  
Serial No.: 10/621,276  
Filed: July 17, 2003  
For: DIOXANES AND USES THEREOF

Examiner: Ward, Paul V.  
Art Unit: 1623  
Confirmation No.: 3033

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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August 29, 2005  
Date

  
Signature  
Kathy Hart Gagnon

Typed or Printed Name of person signing certificate

Sir:

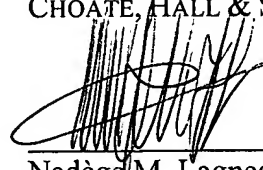
TRANSMITTAL

In response to the Office Action mailed on July 28, 2005 for the above-identified application the following documents are submitted. The deadline for response to the instant Office Action is August 28, 2005, which falls on a Sunday. Therefore, Applicant respectfully submits that the filing of this response on the next business day, August 29, 2005, is timely.

1. Preliminary Amendment and Response to Restriction Requirement (51 pp.); and
2. Return Postcard.

Please charge any additional fees required or credit any overpayments to our Deposit Account No. 03-1721.

Respectfully submitted,  
CHOATE, HALL & STEWART LLP

  
Nadège M. Lagneau, Ph.D.  
Reg. No.: 51,908

Date: August 29, 2005

PATENT GROUP  
CHOATE, HALL & STEWART LLP  
Two International Place  
Boston, MA 02110  
Tel: (617) 248-5150  
Fax: (617) 248-4000



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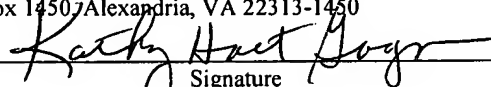
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Sir:

**PRELIMINARY AMENDMENT AND RESPONSE TO RESTRICTION**  
**REQUIREMENT**

This Amendment and Response to Restriction Requirement is submitted in response to the Office Action mailed on July 28, 2005 for the above-identified application. The deadline for response to the instant Office Action is August 28, 2005, which falls on a Sunday. Therefore, Applicant respectfully submits that the filing of this response on the next business day, August 29, 2005, is timely. Prior to examination of the above-referenced application, Applicant respectfully requests entry of the following amendments in the above-referenced patent application:

**Response to Restriction Requirement** begins on page 2

**Amendments to the Specification** begin on page 4 of this paper.

**Amendments to the Claims** are reflected on page 20 of this paper.

**Remarks** begin on page 49 of this paper.

**Conclusions** begin on page 51 of this paper.

This Amendment is believed to be in compliance with the Revised Amendment Format published in the Federal Register on June 30, 2003 (68 FR 38611), and therefore to be exempt from the requirements of 37 C.F.R. § 1.121(a)-(d).

## RESPONSE TO RESTRICTION REQUIREMENT

Applicant respectfully requests reconsideration of the Restriction Requirement of record, and submits that a search of each of compound Groups I-III detailed in the Office Action would not be overly burdensome.

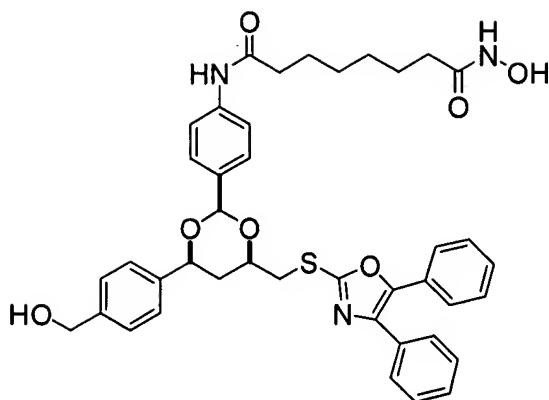
Applicant respectfully directs the attention of the Examiner to MPEP 803.02 "Practice re Markush-type claims", first paragraph, where it is stated: "If the members of the Markush group are *sufficiently few in number* or so closely related that a search and examination of the entire claim can be made without serious burden, the Examiner must examine all the members of the Markush group in the claim on the merits, *even though they are directed to independent and distinct inventions*" (emphasis added).

Applicant respectfully submits that a search of the literature relating to compounds of formula I wherein Y is hydrogen, aliphatic, alicyclic, heteroaliphatic, heterocyclic, aromatic or heteroaromatic (*i.e.*, Groups I, II and III) would not be an undue burden, and invites the Examiner to reconsider the Restriction and include Groups I-III in his examination of the instant claims.

Should the Examiner maintain his position that the presently claimed compounds should be subject to different patent applications, Applicant respectfully requests that the Restriction be reconsidered at least with respect to inclusion of claims directed to compounds or formula I wherein Y is H, aliphatic, alicyclic and aromatic within the same group. Applicant respectfully submits that aromatic and alicyclic both being carbocyclic groups, a search of the compounds of Groups I and III would likely identify similar or overlapping art and thus the examination of Groups I and III simultaneously would not be an undue burden. Applicant respectfully requests that the Examiner consider at least combining Groups I and III in proceeding with examination of the present application.

Notwithstanding Applicant's request for reconsideration of the Restriction, and in order to fulfill the requirement for election set forth in the Restriction Requirement mailed July 28, 2005, Applicant elects **Group III**, directed to claims 1-54 (in part), drawn to compounds and compositions of formula I wherein Y is aromatic.

In addition, Applicant elects the species depicted in claim 52:



Claims readable on the elected species are claims 1, 2, 4-10, 13-17, 19-33, 46, 49, 50, and 52-65.

Applicant explicitly reserves the right to apply for rejoinder of method claims 55-65. To this end, Applicant has amended method claims 60 and 62 to depend from or otherwise include all the limitations of the currently pending compound claims. Applicant understands that method claims 55-65 will be withdrawn from consideration until a compound claim is found allowable, at which time method claims commensurate in scope with the allowed compound claims will be rejoined in accordance with the provisions of MPEP 821.04.